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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|---------------------------|------------------|
| 09/787,945 | 06/26/2001 | Martin Bondo Jorgensen | 0459-0569P | 1016 |
| 30593 | 7590 | 01/25/2006 | EXAMINER | |
| HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195 | | | DABNEY, PHYLESHA LARVINIA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2646 | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|---|--|
| Office Action Summary | Application No. 09/787,945 | Applicant(s) JORGENSEN, MARTIN BONDO | |
| | Examiner Phylesha L. Dabney | Art Unit 2646 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,14-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 3-13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the amendment received on 02 November 2005 in which claims 1-18 are pending.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *“housing is adapted to be placed at a position behind the ear with a controlling means”* as taught in claim 2, and the *microphone/telecoil controlled by the controlling means* of claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

Art Unit: 2646

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 40. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito (U.S. Patent No. 5,708,725).

Art Unit: 2646

since the stiff member is rigid, it will remain in the same position when a deflection force is applied/impinging.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 5,708,725).

Regarding claim 2, Ito '725 teaches a hearing aid according to claim 1, the housing (4-8), wherein the controlling means (7-8, 11-12, 14-15 since these elements are used in conjunction to control switch 20) comprise sensing means (20, 21) positioned on at least one side of the housing facing the head (this is shown in fig. 2 relative to fig. 4 where it is shown that protrusion 21 is located at the innerside of arm 7 and the switch 20 rests at the back of a ledge at the innerside of arm 7) or facing the ear lobe of the user, the sensing means being adapted to sense a force (spring biasing force, col. 5 lines 51-55) applied to the user's auricle, and the controlling means being responsive to the sensing of the sensing means (which reads on the spring biasing force, col. 5 lines 51-54, for pressing the headset to the ears to prevent slippage in conjunction with the retraction force of the spring coils, 15, in the headband arms, col. 5 lines 56-65, used to maintain an on-state of the headset and switches to off when no force is applied). Ito '725 does not teach the housing is adapted to be placed at a position behind the ear. However, it is known in the art to

Art Unit: 2646

alternatively position hearing aid housings (4-8) at a different location, such as at the back of the head for preventing interference with other articles, such as hats, barrettes, etc., that may be on the head. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to position the hearing aid housing of Ito at an alternate location for the reason stated above.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 5,708,725).

Regarding claim 17, Ito teaches that the controlling means comprises circuitry (7-8, 11-12, 14-15, applies tensioning force; circuitry col. 4 line 47 through col. 5 line 18). Ito does not specifically teach that the circuitry comprises an integrated circuit. However, it is well-known to use integrated circuitry in devices, such as hearing aids, to control their function because of their small size, reliability and fast switching, and low power consumption. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an integrated circuitry in the invention of Ito for the reasons stated above.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S. Patent No. 5,708,725) in view of Schmidt et al (U.S. Patent No. 6,775,390).

Regarding claim 16, Ito teaches a hearing aid according to claim 1, wherein the controlling means (20a) are adapted to control the mode of the hearing aid since the control means switches the hearing aid on/off by interrupting the power supply from the battery (col. 5 lines 56-65 and col. 7 lines 15-31). Ito does not teach the hearing aid comprises a microphone.

Art Unit: 2646

Schmidt teaches including a microphone (enclosed in shell 82, col. 3 line 25) in a hearing aid attached to the hearing aid arm (Schmidt, 70; which corresponds to the arm of Ito, 7) to beneficially allow the hearing to be used as a telephonic communication device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a microphone with the hearing aid in the invention of Ito as taught by Schmidt for the reason stated above.

Allowable Subject Matter

7. Claims 3-13, 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ito (U.S. Patent No. 6,542,615) teaches placing the hearing aid at a location behind the head (figures 1-10).

Sacherman et al (U.S. Patent No. 5,369,857) teaches the ability to rotate the hearing aid in all directions (col. 2 37-40).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phylesha L. Dabney whose telephone number is 571-272-7494. The examiner can normally be reached on Mondays, Tuesdays, Wednesdays, Fridays 8:30-4 PM.

Art Unit: 2646

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 11, 2006



PLD



SINH TRAN
SUPERVISORY PATENT EXAMINER